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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/422,804 10/22/99 SOUTHERN

E 00263/PP/IR

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HM12/0228

EXAMINER

MARSCHEL, A	
ART UNIT	PAPER NUMBER

1631
DATE MAILED:

02/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/422,804

Applicant(s)

Southern

Examiner

Ardin Marschel

Group Art Unit

1631



☒ Responsive to communication(s) filed on Dec 6, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 17-99 is/are pending in the application

~~Of the above, claim(s) 1-16 have been canceled. is/are withdrawn from consideration.~~

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 17-99 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Applicants' arguments, filed 12/6/00, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The submission of the substitute specification with abstract and oath is hereby acknowledged and approved and have been entered.

Claims 18, 20-35, 37-39, 42-56, 78, 95, 97, and 99 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Consideration of the instant disclosure as filed has failed to reveal the following newly submitted claim limitations and are therefore NEW MATTER:

claims 18, 38, 42, and 97: 10^{12} locations; It is noted that

1.1 x 10^{12} locations on page 6, line 31, as filed, is not the same as 10^{12} locations.

claim 78: 125 μ m resolution for a detection device

claim 95: about 5 mm wide orthogonal stripes

Claims dependent from the above claims are also included due to

their dependence as containing the NEW MATTER. The lengthy analysis of the written basis for the claims, filed 12/6/00, is acknowledged as appreciated and helpful in this analysis.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 17-99 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over either claims 1-8 of U.S. Patent No. 5,700,637 or claims 1-12 of U.S. Patent 6,054,270. Although the conflicting claims are not identical, they are not patentably distinct from each other because methods of making an array and analysing an array regarding hybridization are claimed in all three sets of claims with details therein varying in the claims but are disclosed in the various specifications as clear species for the performance of each set of claims. The array claims of

the instant application are deemed obvious also over the method of making claims in the Patent 5,700,637 as the arrays made by those methods are clearly suggested via the preparatory claims. It is noted that an array claim is present in Patent 6,054,270.

Claims 17-61 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-26 of copending application Serial No. 09/300,279. Although the conflicting claims are not identical, they are not patentably distinct from each other because methods of making an array and arrays made thereby with details therein varying in the claims but are disclosed in the various specifications as clear species for the performance of each set of claims. The array claims of the instant application are deemed obvious also over the method of making claims.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 96-99 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of copending application Serial No. 09/498,029. Although the conflicting claims are not identical, they are not patentably distinct from each other because methods of labeled (fluorescent) array hybridization analysis are deemed obvious uses for kits for that purpose as claimed in the instant

application.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 96-99 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-28 of copending application Serial No. 09/619,645. Although the conflicting claims are not identical, they are not patentably distinct from each other because methods of making an array and analysing an array regarding hybridization are claimed in both sets of claims with details therein varying in the claims but are disclosed in the various specifications as clear species for the performance of each set of claims. The array claims of the instant application are deemed obvious also over the method of making claims.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 17-99 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-40 of copending application Serial No. 09/422,803. Although the conflicting claims are not identical, they are not patentably distinct from each other because methods of making an array and analysing an array

regarding hybridization are claimed in both sets of claims with details therein varying in the claims but are disclosed in the various specifications as clear species for the performance of each set of claims. The array claims of the instant application are deemed obvious also over the method of making claims.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 17-99 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-29 of copending application Serial No. 09/691,223. Although the conflicting claims are not identical, they are not patentably distinct from each other because methods of making an array and analysing an array regarding hybridization are claimed in both sets of claims with details therein varying in the claims but are disclosed in the various specifications as clear species for the performance of each set of claims. The array claims of the instant application are deemed obvious also over the method of making claims.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

No claim is allowed.


Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703)308-0196.

February 23, 2001


ARDIN H. MARSCHEL
PRIMARY EXAMINER